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IN THE  
**SUPREME COURT OF THE UNITED STATES.**

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OCTOBER TERM, 1943.

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No. 897.

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HENRY I. WARDEN,  
Petitioner,

v.

CITY OF ST. LOUIS, MISSOURI,  
Respondent.

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**BRIEF IN OPPOSITION TO WRIT  
OF CERTIORARI.**

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**Statement.**

The basis of this whole suit is petitioner's claim that a conventional automobile windshield sticker license, comprising a piece of every-day decalcomania with the usual and necessary serial numbers thereon, is invention.

It is no more than that—a few regular symbols on an ordinary decalcomania, for sticking to a windshield. Claim 3 of petitioner's patent, read forward or backward, has no more in it than that.

The City of St. Louis has already had to defend itself in two courts against this absurd claim. Both courts, of course, held the patent invalid. Now petitioner apparently expects this court to reverse both lower courts.

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Decalcomanias with serial numbers are admittedly old in the art. (See Howard patents, R. 59, 63, 67, 71.) These are identical in every respect with petitioner's article. They were described as used for meat inspection tags, instead of automobile license tags. In other words, the difference is only one of *use*.

Windshield license stickers made of paper, with the usual serial numbers, were used several years before petitioner's claimed invention (R. 286, 293). These are identical with his patent claim, except for the matter of using decalcomania instead of paper.

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Petitioner himself admitted that the use of decalcomania stickers, without serial numbers, on automobiles, was old (R. 13, 16, Int. 6). In fact, he probably had an automobile club decalcomania on his car at the time of his claimed invention (R. 37).

Not only that, but petitioner admitted that decalcomania stickers, *with* serial numbers, were used on glass other than automobile windshields (R. 13, 16, Int. 6). Thus his maximum claim to invention lay in using the old device on automobile glass instead of shop door glass.

### **The Issues.**

Therefore, the whole issue, decided uniformly by the courts below, resolves itself into whether it was invention either

(a) to employ a decalcomania with serial numbers, concededly old, on an automobile glass instead of on some other object, or

(b) to substitute decalcomania, concededly old, as the material for paper in windshield license stickers with serial numbers, the paper stickers being concededly old.

## The Legal Precedents.

It is an unquestioned and venerable rule of law that a different use of the same old article is not invention. Thus, employing the meat sticker as an automobile sticker, is not invention.

*Roberts v. Ryer*, 91 U. S. 150;

*Ansonia Brass & Copper Co. v. Electrical Supply Co.*, 144 U. S. 11;

*Phillips v. Page*, 65 U. S. 164.

It is an unquestioned and venerable rule of law that substituting one known material for another, merely to obtain the obvious and familiar properties of the substituted material, is not invention.

*Hotchkiss v. Greenwood*, 11 How. 247.\*

It is further a prerequisite of patentability that something more than ordinary intelligence be demonstrated. Making a license sticker out of a few symbols printed into a decalcomania was not, and never could have been, invention.

*Cuno Engineering Corp. v. Automatic Devices Corp.*,  
314 U. S. 84.

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\*It is interesting to observe that both of these rules are set out in a single statement of Thomas Jefferson, in a letter reviewing his own experience on the patent board when he was Secretary of State. He said (Jefferson's Works, Vol. XIII, p. 326):

"Some (rules), however, were established by that board. One of these was, that a machine of which we are possessed, might be applied by every man to any use of which it is susceptible, and that this right ought not to be taken from him and given to a monopolist, because the first perhaps had occasion so to apply it. Thus a screw for crushing plaster might be employed for crushing corncocks. And a chain pump for raising water might be used for raising wheat; this being merely a change of application. Another rule was that a change of material should not give title to a patent. As the making a ploughshare of cast rather than of wrought iron; a comb of iron instead of horn or ivory, or the connecting buckets by a band of leather rather than of hemp or iron. A third was that a mere change of form should give no right to a patent, as a high-quartered shoe instead of a low one; a round hat instead of a three-square; or a square bucket instead of a round one. But for this rule all the changes of fashion in dress would have been under the tax of patentees."



Both courts below held petitioner's patent invalid for the foregoing reasons. The result was unmistakably proper and conventional, and presents no trace of reason for review by another court. The patent is dead and may well be left alone.

*Goodyear T. & R. Co. v. Ray-O-Vac Co.*, ... U. S. ... , 88 L. ed. 475.

### **Petitioner's Arguments.**

Petitioner offers three alleged points that are wholly fallacious.

Point I urges that a court may not hold invalid a patent that has enjoyed commercial success. This is not true. Commercial success is never a substitute for invention. The Court of Appeals held that there was not invention in the patent, *despite* the commercial success. The District Court (we think rightly) further held that there was no true commercial success, measured against the proper standards.

Neither view changes by one iota the recognized law. Lack of invention being plain, commercial success is of no consequence.

*Textile Machine Works v. Louis Hirsch T. M.*, 302 U. S. 490;

*Toledo Pressed Steel Co. v. Standard Parts*, 307 U. S. 350.

Point II avers that the Court of Appeals should not have declared the patent invalid, because *Roberts v. Ryer*, 91 U. S. 150, does not apply. A threshold answer to this is that the ultimate result reached was correct, and this Court should not be asked to advise the Court of Appeals to cite a different prior decision.

On the merits, moreover, petitioner is wrong. The facts are (and they are *facts* agreed upon by both lower courts)

that petitioner did not create a new device, but only employed an old one for a new use. *Roberts v. Ryer* is applicable authority for the *factual* conclusion reached below.

Point III avers that the validity of the patent is of great public importance. To the contrary, its *invalidity* is of great public importance, and that result has been properly reached by the courts below.

### **Conclusion.**

Respondent argued below that under no interpretation of the requisites of invention, old or new, could this device be considered invention. There is no new point here involved. The case represents only a conventional application of familiar doctrines that have lived without change through decades of patent adjudication.

The imprinting of a few obvious symbols onto decalcomania, for sticking onto a windshield, is not invention.

Respectfully submitted,

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